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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,882	01/26/2001	James D. Hempleman	PRE2519P0011US	6661

7590 11/04/2003  
WELSH & KATZ, LTD.  
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CHICAGO, IL 60606

EXAMINER

KINDRED, ALFORD W

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 11/04/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/770,882

Applicant(s)

HEMPLEMAN ET AL.

Examiner

Alford W. Kindred

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-145 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-57,66 and 117 is/are allowed.
- 6) ☒ Claim(s) 58-61,63,64,67-71,74-83,89-96,99-110,113-116 and 118-131 is/are rejected.
- 7) ☒ Claim(s) 62, 65, 72-73, 84-88, 97-98, and 111-112 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is responsive to communication: Amendment E, filed on 08/11/2003.  
  
This action is made final.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 58—61 and 63-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Allison, US# 5,668,788.

As per claim 58, Allison teaches “accessing at least one source of works . . . creating and storing multiple play lists . . .” (see col. 3, lines 35-67) “play list and for maintaining popularity information pertaining to works from . . . play list” (see col. 3, lines 1-28).

As per claim 59, Allison teaches “obtaining works not locally . . .” (see col. 2, lines 48-67, whereas Allison’s computer element includes the communication means to obtain data remotely, as taught in applicant’s claim language).

As per claim 60, Allison teaches “presenting advertisements” (see col. 3, lines 7-25).

As per claim 61, Allison teaches "works selected in accordance with a pre-established criterion" (see col. 2, lines 14-40).

As per claims 63-64, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 58-61 and are similarly rejected.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 67-71, 74-83, 89-96, 99-110, 113-116, and 118-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allison, in view of Janky, US# 5,914,941.

As per claims 67-71, 75-77 and 89, Allison teaches "a user station for creating at least one list of multiple works" (see col. 2, lines 53-67). Allison does not explicitly teach "at least in part at the user station for downloading at least some of the works on the list . . .". Janky teaches "at least in part at the user station for downloading at least some of the works on the list . . ." (see col. 11, lines 3-24). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Allison and Janky because using the steps of "at least in part at the user station for downloading at least some of the works on the list . . ." would have given those skilled in the art the tools to transfer data from a centralized source to a target source via a

network. This gives users the advantage of retrieving, using and/or manipulating data from various remote sources.

As per claims 74 and 80, Allison teaches "the user station graphically displays simultaneously at least some of an invention of available works . . ." (see col. 2, lines 53-67).

As per claims 78-79, Allison teaches "controlling a media writing device, coupled . . . a removable medium . . ." (see col. 2, lines 20-35, whereas Allison's computer contains a hard drive that is capable of being removed with the data intact, as illustrated in applicant's claim language.

As per claims 81-83, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 74 and are similarly rejected including the following:

--Allison teaches "the list include advertisement" (see col. 1, lines 60-67).

As per claims 90-91, Allison teaches "list comprise video . . ." (see col. 1, lines 35-63).

As per claims 92-96, 99-100, 104-110, 113-116 and 118, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 58-61 and 67-70 and are similarly rejected.

As per claims 120-124, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 67-71 and 76-81, above and are similarly rejected including the following:

--Allison teaches "enabling a local user to restrict the works displayed . . ." (see fig. 3—sheet 2 of 2 (i.e. S2 allows the restriction of works)).

--Allison teaches "selected works on the list can be written to removable medium . . ." (see 2, lines 20-30, whereas Allison's "data storage 8" is removable).

As per claims 125-131, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 63-64 and 67-17 and are similarly rejected.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 30-145 have been considered but are not persuasive in view of the original ground(s) of rejection.

--As per applicant's arguments regarding "Allison discloses and teaches only creation of a singular play list which is made up of inputs from a variety of different touch panels . . ." examiner maintains that Allison's different panels are separate and thus include separate play lists and therefore teach applicant's claim language involving multiple play lists.

--As per applicant's arguments regarding "neither Allison nor Janky alone or in combination disclose, suggest or make . . . 'control software enabling a local user to sort at least some of the works in remote inventory . . . ' . . .", examiner maintains that Allison's "creation of play lists combined with Janky's playback elements teaches applicant's claim language above.

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--As per applicant's arguments regarding "Allison and Janky, alone or in combination, neither one of them . . . claimed 'media writing device, . . . works can be written to a removable medium' . . .", examiner maintains that Allison's play lists are stored on a memory device, which is removable. Further, Allison's play lists changes and therefore has the capacity to delete, add or modify the lists and therefore teach applicant's claim language.

--As per applicant's arguments regarding neither Allison nor Janky . . . suggest . . . 'wherein alt least some of the works on the list include advertisements' . . .", examiner maintains that Allison's displaying of advertisements, which includes the advertisements related to the subject at hand, clearly read on applicant's claim language above.

Note: "Jenke" should read "Janky" in applicant's arguments.

***Conclusion***

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford W. Kindred whose telephone number is 703-305-3802. The examiner can normally be reached on Mon-Fri 9:00 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Klm Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

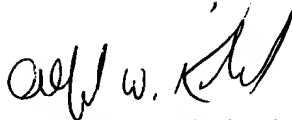


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

A handwritten signature in black ink, appearing to read 'Alford W. Kindred', with a stylized flourish at the end.

Alford W. Kindred  
Patent Examiner  
Tech Ctr. 2100